

REMARKS/ARGUMENTS

Claims 33, 36-37, 39-57, and 61-74 were previously pending in the application. Claims 44-45, 47-48, 62, and 67 are canceled; claims 33, 46, 49, 57, 63, 65, and 70 are amended; and new claims 75-76 are added herein. Assuming the entry of this amendment, claims 33, 36-37, 39-43, 46, 49-57, 61, 63-66, and 68-76 are now pending in the application. The Applicant hereby requests further examination and reconsideration of the application in view of the foregoing amendments and these remarks.

Claim Rejections - 35 U.S.C. 112

In paragraph 2 of the office action, the Examiner rejected claim 70 under 35 U.S.C. 112, second paragraph, as being indefinite. In response, the Applicant has amended claim 70 to clarify that the correction signal is introduced between the step of signal amplification and the step of frequency conversion. Since claim 70 does not restrict the order of the steps of signal amplification and frequency conversion, the Applicant submits that claim 70 covers (i) methods comprising signal amplification followed by introduction of the correction signal followed by frequency conversion as well as (ii) methods comprising frequency conversion followed by introduction of the correction signal followed by signal amplification. In view of the foregoing, the Applicant submits that the rejection of claim 70 under 35 U.S.C. 112, second paragraph, has been overcome.

Claim Rejections

In paragraph 3, the Examiner rejected claims 33, 39-45, 54, 57, 61-62, 65, and 70-74 under 35 U.S.C. 103(a) as being unpatentable over Shalom in view of Narahashi. In paragraph 4, the Examiner rejected claims 46-47, 49, 55, 63, 65-66, and 68 under 35 U.S.C. 103(a) as being unpatentable over Shalom in view of Narahashi in view of Faulkner. In paragraph 5, the Examiner rejected claims 36 and 51-52 under 35 U.S.C. 103(a) as being unpatentable over Shalom in view of Narahashi in view of Dent. In paragraph 6, the Examiner rejected claim 53 under 35 U.S.C. 103(a) as being unpatentable over Shalom in view of Narahashi in view of Dent, further in view of Faulkner. In paragraph 7, the Examiner rejected claims 37, 56, and 64 under 35 U.S.C. 103(a) as being unpatentable over Shalom in view of Narahashi in view of McNicol.

The Applicant submits that the rejections of claims 33 and 57 are improper. As the Examiner admits, while it is true that Shalom discloses a signal amplifier, a frequency converter, a lineariser, and a feedback signal, Shalom fails to disclose a pilot signal generator and the removal of the pilot signal from the output of the apparatus. Instead, the Examiner cites Narahashi as disclosing a pilot signal generator and the removal of the pilot signal from the output of the apparatus.

The Applicant submits that there is no motivation in the prior art for modifying the apparatus disclosed in Shalom to include the cited features disclosed by Narahashi. Nor has the Examiner provided any explanation of what that motivation might be. Rather, the rejection of claims 33 and 57 appears to be based on nothing more than classic improper hindsight, where the Examiner uses the Applicant's own specification as a template for combining references to reject the Applicant's invention. Just because the prior art teaches all of the features of the claimed invention, that does not mean that the claimed invention is obvious over that prior art. In particular, even if there were motivation in the prior art to add a pilot signal in the system disclosed in Shalom (which the Applicant does not admit), the Applicant submits that there is no suggestion in the prior art for adding such a pilot signal prior to frequency conversion in a system such as Shalom in which frequency conversion precedes signal amplification.

For all these reasons, the Applicant submits that the rejections of claims 33 and 57 based on a combination of Shalom and Narahashi is improper.

Allowable Subject Matter

In paragraph 8, the Examiner objected to claims 48, 50, 67, and 69 as being dependent upon a rejected base claim, but indicated that those claims would be allowable if rewritten in independent form. For the following reasons, the Applicant submits that all of the pending claims are allowable over the cited references.

Claim 33 has been amended to include the features of previously pending claims 44-45 and 47-48. Claim 57 has been amended to include the features of previously pending claim 62, 45, and 47-48. For at least some of the same reasons that the Examiner indicated that previously pending claim 48 was directed to allowable subject matter, the Applicant submits that currently amended claims 33 and 57 are allowable. Since claims 36-37, 39-43, 46, 49-56, 62-64, and 71-74 depend variously from claims 33 and 57, it is further submitted that those claims are also allowable.

Claim 65 has been amended to include the features of previously pending claim 67. As such, currently amended claim 65 is equivalent to previously pending claim 67 rewritten in independent form. Since the Examiner stated that previously pending claim 67 would be allowable if rewritten in independent form, the Applicant submits that currently amended claim 65 is allowable. Since claims 66 and 68-69 depend variously from claim 65, it is further submitted that those claims are also allowable.

Claim 70 has been amended to include the features of previously pending claim 67. For at least some of the same reasons that currently amended claim 65 is allowable, the Applicant submits that currently amended claim 70 is also allowable.

Support for new claim 75 is found in previously pending claims 33, 44-45, 47, and 49-50. For at least some of the same reasons that the Examiner indicated that previously pending claim 50 was directed to allowable subject matter, the Applicant submits that new claim 75 is allowable.

New claim 76 is equivalent to previously pending claim 69 rewritten in independent form. Since the Examiner stated that previously pending claim 69 would be allowable if rewritten in independent form, the Applicant submits that new claim 76 is allowable.

In view of the above amendments and remarks, the Applicant believes that the now-pending claims are in condition for allowance. Therefore, the Applicant believes that the entire application is now in condition for allowance, and early and favorable action is respectfully solicited.

Respectfully submitted,

Date: 05/18/2007
Customer No. 22186
Mendelsohn & Associates, P.C.
1500 John F. Kennedy Blvd., Suite 405
Philadelphia, Pennsylvania 19102

/Steve Mendelsohn/
Steve Mendelsohn
Registration No. 35,951
Attorney for Applicant
(215) 557-6657 (phone)
(215) 557-8477 (fax)